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| 09/763,141 | 01/17/2002 | Jin-Yong Joo | 122990-05163075 | 3416 |
| 23429 7590 11/30/2009 LOWE HAUPTMAN HAM & BERNER, LLP 1700 DIAGONAL ROAD SUITE 300 ALEXANDRIA, VA 22314 | | | | |
| EXAMINER CARLSON, JEFFREY D | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/763,141

Applicant(s)

JOO ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This action is responsive to the paper(s) filed 7/7/2009.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 3-9, 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Viral Marketing (Steve Jurvetson and Tim Draper) in view of Goldhaber et al (US5794210) and Moncur (Javascript in 24 hrs).**
3. Regarding claims 1, 9, 12-20, Viral Marketing teaches the concepts of providing free email services that include viral advertising embedded within from one user to his (friends) recipients. These messages "imply endorsement" from the sender to the user and therefore are a more powerful form of advertising over ads from unknown senders. Viral Marketing also teaches that the "customers (senders) do the selling" of the advertised products and the concept is likened to multi level marketing where customers are treated like "distribution partners" and are paid for their word of mouth viral advertising. Viral Marketing does not mention compensating the recipient of the viral advertising. However Goldhaber et al teaches the concept of negatively priced information whereby consumer who consume advertising information are paid for their (tracked/monitored) attention [abstract]. In particular, readers of emails can be paid for

their attention in reading emails [col 6 lines 3-23]. It would have been obvious to one of ordinary skill at the time of the invention to have tracked the sending, delivery and display of such viral advertising and paid not only the sender as suggested by Viral Marketing, but also the recipients as taught by Goldhaber et al. Regarding the "activating member" to convert the advertising between activated and inactivated states, Moncur (Javascript in 24 hrs) teaches that javascript can be used to manipulate windows and content on a web page and it would have been obvious to one of ordinary skill at the time of the invention to have provided a wide variety of javascript code with an HTML email in order to provide an interface for mail recipients to display and interact with the advertising in the email. Moncur (Javascript in 24 hrs) teaches specifically that dynamic HTML can be used in order to cache hidden images and then javascript controls (such as clickable buttons) can be used to reveal the hidden images. It would have been obvious to one of ordinary skill at the time of the invention to have provided a wide variety of javascript code in an HTML email containing advertising (ad images, for example) so that a user could selectively toggle (i.e. using a single button) the ad images to be hidden and revealed and vice versa. Doing so would provide a means for the email recipient to control the visibility of the advertisement using known javascript techniques. Enabling the user to hide the advertising would also enable the user to focus on the email content until such time that the user desires to view the advertising content. Further, providing the email with ad content in an initial activated/visible state would also enable the user to hide the advertising after he has reviewed the advertising. Further, Official Notice is taken that other well interface elements are well known such

as a scrollbar and popup tooltip which would have been obvious to have included with an advertising email. For example a scroll bar provided for a long email having embedded advertising could be the “activating member” which is used to scroll the ad on and off the screen – thereby activating and deactivating the advertising. Also a popup tool tip (balloon help feature) is another well known interface element that would have been obvious to have provided with the email so as to enable the user to popup or reveal advertising content associated with the email. Regarding the download of emails by the sender, the well-known concept of web mail as mentioned by Viral Marketing inherently indicates that email messages are downloaded for editing and then delivered by a server. Likewise, use of an email client provides delivery of emails from the sender PC to a server and ultimately to a user’s PC who may also optionally use webmail or a local mail client.

4. Regarding claims 3-5, 8, given Viral Marketing’s teaching that the sender is endorsing the product advertised, it would have been obvious to one of ordinary skill at the time of the invention to have enabled the sender to have chosen an advertisement (from among advertising email pages as choices) having content that the sender was comfortable endorsing and/or that the sender believes his recipient/friend would find beneficial. It would be predictably senseless and discouraging to have been forced to send an advertisement for a product or company for which the sender (or if the sender is aware, the recipient) carries ill-feelings.
5. Regarding claim 6, it would have been obvious to one of ordinary skill at the time of the invention for any entity to have sent an advertisement with the proposed system

including a lottery provider who entices prospects with vouchers/coupons for free lottery tickets in an attempt to attract future lottery sales from the consumers.

6. Regarding claim 7, Official Notice is taken that SPAM or bulk emailing is a well known and fraudulent practice. It would have been obvious to one of ordinary skill at the time of the invention to have deprived bad actors of compensation where they are determined to be sending countless emails to limitless recipients in an attempt to fraudulently gain the system for revenue. Allowing payments to senders who SPAM others would not only be a waste of money, but would be paying for emails that would predictably be seen by the SPAM-recipients as unwanted, doing harm to the brand being advertised.

Response to Arguments

Applicant argues that the well known icon/button/link used to reveal an email attachment cannot read on the present claims. This argument is moot given the new grounds of rejection.

Applicant argues that the term viral refers to customers who are not active sellers and who do not choose to spread a virus – much as a patient does not choose to spread a medical virus. Applicant argues that the Viral Marketing is involuntary and therefore does not teach choosing an ad. The viral nature of the applied art is that the marketing/advertising is effectively passed to 2 friends...who tell 2 friends...who tell 2 friends, etc., spreading like a virus – rather than there is no participation or involuntary participation. In fact quite the opposite, the reference Viral Marketing specifically

mentions MLM techniques which are very much voluntary participation. Applicant argues that that Viral Marketing fails to recite "active sellers" as argued by the examiner. Applicant argues that Viral Marketing fails to teach the meaning of multi level marketing (MLM) nor would one of ordinary skill at the time consider MLM to include active selling. As evidenced by the newly cited NPL (MLM is a growing trend) it is clear that this is a well known concept in the art of marketing and it includes a network of friends selling to friends. The effectiveness of MLM at least partially is attributed to word of mouth and person to person contact and sales techniques. Given the teachings of Viral Marketing in the context that MLM is a well known technique for friends selling to friends or users selling to other users, it would have been obvious to one of ordinary skill at the time of the invention to have allowed for screening and/or choice of advertisements to be included with sender emails. This would be a predictable way for senders to endorse products that they deem worthy of endorsement as well as enable senders to endorse products that they believe the recipient/friend would enjoy learning more about. Allowing ad selection by the sender would therefore predictably increase the effectiveness of the endorsed products/ads.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc